



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/239,878 | 01/29/1999 | MARK L. BOYER | 07091-006001 | 6652 |

7590 06/07/2006
MARK J GATSCHET
JENKENS & GILCHRIST
1401 MCKINNEY
SUITE 2600
HOUSTON, TX 77010

EXAMINER

CANFIELD, ROBERT

ART UNIT PAPER NUMBER

3635

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,878

Applicant(s)

BOYER ET AL.

Examiner

Robert J. Canfield

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,36,37 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33, 34, 36, 37 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3635

1. This Office action is in response to the amendment filed 03/31/06. Claims 33, 34, 36, 37 and 39-43 are pending with claim 39 being withdrawn from consideration for being directed to a non-elected invention. Claims 1-32, 35 and 38 have been canceled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 33, 36, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,519,727 to Fritz.

Fritz provides a modular vault which is formed of a unitarily cast or formed single piece seamless body 12 having walls, a floor, a roof, a door 9 mounted within a door frame 6/20, and lining 14 which ensures vapor-tightness. Hooks 42 are provided, however, they are not formed in the housing body, but rather the door.

4. Claims 33, 36, 40 and 42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 1,400,104 to Thorig.

Thorig provides a secure vault formed from a single monolithic concrete body (a), having a door frame (n) positioned within a door opening, and a door (b) mounted to the door frame. Page 2, lines 36-38 recites that fire, smoke and gases cannot penetrate the interior. Thus the vault is considered to be vapor tight. The term "walk-in" fails to

provide any specific dimensions. While Thorig is silent as to the size of his vault it is considered to be capable of being walked into.

Alternatively, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device is not patentably distinct from the prior art device. It would have been obvious at the time of the invention to one of ordinary skill in the art that the safe or "vault" of Thorig could have been sized or scaled as desired, such as large enough to be walked into by an average size person, without departing from or changing the basic function of providing a fire proof burglar resistant safe/vault.

5. Claims 34, 37, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,400,104 to Thorig in view of U.S. Patent 2,103,005 to Handly.

Thorig provides each of the elements of these claims except for providing a plurality of hooks integrally formed into the housing body (a) to facilitate hoisting.

Handley teaches that at the time of the invention it was known to provide concrete vaults with hooks integrally formed to the body to assist in lifting the vault.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the concrete vault of Thorig could have been provided in the roof thereof with integral hooks as taught at 27 by Handley to assist in lifting the vault due to

Art Unit: 3635

the great amount of weight the vault inherently must weigh since it is formed of concrete.

6. Applicant's arguments filed 03/31/06 have been fully considered but they are not found fully persuasive.

The argument that Fritz, Thorig and Handly fail to meet the limitations of a "modular vault" is not found persuasive. The vaults of each of Fritz, Thorig and Handly are as modular as applicant claimed device and meet at least the first definition of "modular" provided in applicant's remarks. The argument that Fritz fails to provide a door frame is not found persuasive because as noted in the rejection elements 6/20 are considered to provide a door frame.

The argument that Thorig fails to provide a modular walk in vault is not found persuasive. First, the language "walk in" fails to provide any specific dimensions. It is noted that the features upon which applicant relies (i.e., large enough to accommodate a person of typical height walking into the safe) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's analysis of the dimensions is not found persuasive because MPEP 2125 clearly states that proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale. Even if one were to agree that

Art Unit: 3635

Thorig implicitly discloses small dimensions the scaling up in size would have been obvious to one having ordinary skill in the art as now noted above.

The argument that Thorig fails to provide a door frame is not found persuasive as the reference shows and discusses frame n including border p.

In response to applicant's argument that Handly is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Handly is considered reasonable pertinent to the particular problem of assisting in lifting of concrete vaults by providing hooks 27.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635



06/02/06